

Opposition No. _____
Application Serial No. 86/297459
AMERICAN COUNTESS
Application Serial No. 86/277094
AMERICAN PRINCESS

U.S. Patent and Trademark Office #72

NOTICE OF OPPOSITION

1. Opposer is now, and for many years has been, engaged in the business of Cruise ship services; transportation of passengers by ship; arranging and conducting cruises for others.
2. Opposer's services are offered in the United States under various trademarks, a number of which are comprised of two words, the first of which is AMERICAN.

3. Opposer has long advertised and promoted its overnight passenger cruise ship services for its fleet of overnight passenger ships in connection with (i) American Cruise Lines' federally registered service mark AMERICAN CRUISE LINES, U.S. Service Mark Registration No. 3,019,486, issued by the U.S. Patent and Trademark Office ("PTO") on November 29, 2005, as registered on the Principal Register in connection with "cruise ship services; transportation of passengers by ship" in International Class 39 (hereinafter the '486 Registration); (ii) American Cruise Lines' federally registered service mark AMERICAN GLORY, U.S. Service Mark Registration No. 2,908,064, issued by the PTO on December 7, 2004, as registered on the Principal Register in connection with "cruise ship services; transportation of passengers by ship" in International Class 39 (hereinafter the '064 Registration); (iii) American Cruise Lines' federally registered service mark AMERICAN SPIRIT, U.S. Service Mark Registration No. 2,987,886, issued by the PTO on August 23, 2005, as registered on the Principal Register in connection with "cruise ship services; transportation of passengers by ship" in International Class 39 (hereinafter the '886 Registration); (iv) American Cruise Lines' federally registered service mark AMERICAN STAR, U.S. Service Mark Registration No. 3,409,555, issued by the PTO on April 8, 2008, as registered on the Principal Register in connection with "cruise ship services; transportation of passengers by ship" in International Class 39 (hereinafter the '555 Registration).
4. A copy of the '486 Registration is attached hereto as Exhibit A; copy of the '064 Registration is attached hereto as Exhibit B; a copy of the '886 Registration is

attached hereto as Exhibit C, a copy of the '555 Registration is attached hereto as Exhibit D.

5. The AMERICAN CRUISE LINES service mark, subject of the '486 Registration, has been continuously in use by American Cruise Lines in interstate commerce in connection with overnight passenger cruise ship services on the fleet of cruise ships and riverboats owned or chartered by American Cruise Lines and operating under the AMERICAN Vessel Marks and related marks on inland and coastal waterways and rivers of the United States since at least as early as 1999 and is currently in use. American Cruise Lines has used and is using its AMERICAN CRUISE LINES mark in combination with its various other registered "AMERICAN" prefaced marks and related marks to identify and distinguish its services as operator of a fleet of overnight passenger cruise ships and paddlewheel riverboats from services provided by others and to indicate the source of those services.
6. The AMERICAN GLORY service mark, subject of the '064 Registration, has been continuously in use by American Cruise Lines in interstate commerce in connection with overnight passenger cruise ship services on inland and coastal waterways and rivers of the United States since at least as early as 1999 and is currently in use. American Cruise Lines has used and is using the mark AMERICAN GLORY in combination with its AMERICAN CRUISE LINES mark and its other registered "AMERICAN" prefaced marks to identify and distinguish its services as operator of a fleet of overnight passenger cruise ships from services provided by others and to indicate the source of those services.

7. The AMERICAN SPIRIT service mark, subject of the '886 Registration, has been continuously in use by American Cruise Lines in interstate commerce in connection with overnight passenger cruise ship services on inland and coastal waterways and rivers of the United States since at least as early as May, 2005 and is currently in use. American Cruise Lines has used and is using the mark AMERICAN SPIRIT in combination with its AMERICAN CRUISE LINES mark and its other registered "AMERICAN" prefaced marks to identify and distinguish its services as operator of a fleet of overnight passenger cruise ships from services provided by others and to indicate the source of those services.
8. The AMERICAN STAR service mark, subject of the '555 Registration, has been continuously in use by American Cruise Lines in interstate commerce in connection with overnight passenger cruise ship services on inland and coastal waterways and rivers of the United States since at least as early as June, 2007 and is currently in use. American Cruise Lines has used and is using the mark AMERICAN STAR in combination with its AMERICAN CRUISE LINES mark and its other registered "AMERICAN" prefaced marks to identify and distinguish its services as operator of a fleet of overnight passenger cruise ships from services provided by others and to indicate the source of those services.
9. Pursuant to §15 of the Lanham Act, 15 U.S.C. §1065, the '486 Registration became incontestable as of March 9, 2011; the '064 Registration became incontestable as of March 11, 2011; the '886 Registration became incontestable as of March 11, 2011; and the '555 Registration became incontestable as of June 14, 2013.

10. American Cruise Lines also has long advertised and promoted its overnight passenger cruise ship services for its fleet of overnight passenger ships, and in particular for its first overnight passenger cruise ship, the “American Eagle,” in connection with the common law trademark AMERICAN EAGLE. In connection with overnight passenger cruising on inland and coastal waterways and rivers of the United States, the AMERICAN EAGLE mark is distinctive. The AMERICAN EAGLE mark was first used in interstate commerce by American Cruise Lines in 1999. American Cruise Lines continuously used the AMERICAN EAGLE mark in interstate commerce in connection with overnight passenger cruising on inland and coastal waterways and rivers of the United States for about a dozen years until the vessel “American Eagle” was laid up. The vessel “American Eagle” remains owned by American Cruise Lines and, in combination with the AMERICAN CRUISE LINES mark and the AMERICAN Vessel Marks, the AMERICAN EAGLE mark is a valuable and protectable mark with associated goodwill and an asset of American Cruise Lines useful to identify and distinguish its services from those provided by others and to indicate the source of those services.
11. On June 3, 2013 American Cruise Lines filed Application Serial No. 85/949372 in the U.S. Patent and Trademark Office to register the mark AMERICAN EAGLE in connection with “Cruise ship services; transportation of passengers by ship; arranging and conducting cruises for others.” Said application has been approved and a Notice of Allowance issued December 24, 2013.

12. Consumers recognize the “AMERICAN” prefix as an indicator of a common source of “cruise ship services; transportation of passengers by ship.”
13. The trademarks identified in ¶3 and ¶10 when taken together, constitute a family of trademarks (“AMERICAN Family”).
14. Opposer’s AMERICAN CRUISE LINES mark and AMERICAN Family of Marks are widely recognized throughout the United States as designating the top quality overnight passenger cruising services which Opposer offers and the cruise ships on which those services are offered. Opposer’s AMERICAN CRUISE LINES mark and AMERICAN Family of Marks have achieved widespread public recognition throughout the United States in connection with overnight passenger cruise ships and services.
15. Opposer has used its AMERICAN Family of marks in the U.S. since prior to any date that may be relied upon by the Applicant in connection with the marks subject to this opposition.
16. Applicant did not use the trademark AMERICAN COUNTESS in the United States for the services described in its application prior to June 2, 2014.
17. Applicant did not use the trademark AMERICAN PRINCESS in the United States for the services described in its application prior to May 9, 2014.
18. The services in Class 39 for which Applicant seeks to register the marks AMERICAN COUNTESS and AMERICAN PRINCESS are substantially identical to the services offered by Opposer under its AMERICAN Family of marks.

19. The trademarks AMERICAN COUNTESS and AMERICAN PRINCESS sought to be registered by the Applicant are substantially similar to Opposer's AMERICAN Family of trademarks.
20. Applicant was aware of Opposer's trademarks as set forth in ¶3 at the time it filed its applications to register the trademarks AMERICAN COUNTESS and AMERICAN PRINCESS.
21. Applicant was aware of Opposer's name and mark AMERICAN CRUISE LINES at the time it filed its applications to register the trademarks AMERICAN COUNTESS and AMERICAN PRINCESS.
22. Consumers are likely to be confused and to mistakenly believe that Applicant's services offered under its trademarks AMERICAN COUNTESS and AMERICAN PRINCESS either emanate from or are licensed by, sponsored by, or associated with Opposer.
23. Consumers are likely to be confused and to mistakenly believe that Applicant's services offered under its AMERICAN COUNTESS and AMERICAN PRINCESS marks are part of the services offered by Opposer under its AMERICAN Family of trademarks.
24. If the Applicant were permitted to use and register its marks for its services as specified in its applications, confusion among consumers resulting in damage and injury to Opposer would be caused by virtue of the similarity between Applicant's trademarks and Opposer's trademarks, and the related nature of the services covered by those marks. Any defect, objection or fault found with Applicant's services would reflect upon, seriously injure, and dilute the reputation and value that Opposer has established under its trademarks.

WHEREFORE, Opposer prays that Applications Serial Nos. 86/297459 and 86/277094 be rejected, that no registrations be issued thereon to Applicant, and that this opposition be sustained in favor of the Opposer.

This Notice of Opposition is submitted together with the statutory filing fee of \$600.00. Should any additional fee be required, please charge the same to our Account No. 22-0261 and notify the undersigned accordingly.

Opposer appoints Mark B. Harrison, Rebecca Liebowitz, Linda Zirkelbach, Janet Satterthwaite, Jeremy Klass and Halle Markus along with the law firm of Venable LLP, P.O. Box 34385, Washington, D.C. 20043-9998 to transact all business on its behalf in connection with this Opposition.

Respectfully submitted,



Date: October 24, 2014

By: _____

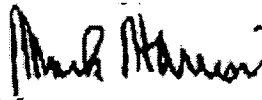
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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **NOTICE OF OPPOSITION** was served by U.S. Mail, first class, postage prepaid, on this 24th day of October 2014 on the Applicant's attorney of record at the address listed in the current U.S. Trademark Office Records as follows:

ROBERT P. HERRE
PO BOX 384
GOSHEN, KENTUCKY 40026-0384

A handwritten signature in black ink, appearing to read "Mark Harrison", is written above a horizontal line.

Mark Harrison

EXHIBIT A

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AMERICAN CRUISE LINES

Word Mark AMERICAN CRUISE LINES

Goods and Services IC 039. US 100 105. G & S: CRUISE SHIP SERVICES; TRANSPORTATION OF PASSENGERS BY SHIP. FIRST USE: 19990730. FIRST USE IN COMMERCE: 19991001

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 76615930

Filing Date October 14, 2004

Current Basis 1A

Original Filing Basis 1A

Published for Opposition September 6, 2005

Registration Number 3019486

Registration Date November 29, 2005

Owner (REGISTRANT) AMERICAN CRUISE LINES, INC. CORPORATION DELAWARE 741 Boston Post Road, Suite 200 Guilford CONNECTICUT 06437

Attorney of Record Mark B. Harrison

Prior Registrations 2437726;2437727

Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE CRUISE LINES APART FROM THE MARK AS SHOWN

Type of Mark SERVICE MARK

Register PRINCIPAL-2(F)
Affidavit Text SECT 15. SECT 8 (6-YR).
Live/Dead Indicator LIVE

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AMERICAN GLORY

Word Mark	AMERICAN GLORY
Goods and Services	IC 039. US 100 105. G & S: CRUISE SHIP SERVICES; TRANSPORTATION OF PASSENGERS BY SHIP. FIRST USE: 19990000. FIRST USE IN COMMERCE: 19990000
Mark Drawing Code	(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
Serial Number	76564129
Filing Date	December 9, 2003
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	September 14, 2004
Registration Number	2908064
Registration Date	December 7, 2004
Owner	(REGISTRANT) AMERICAN CRUISE LINES, INC. CORPORATION DELAWARE 741 Boston Post Road, Suite 200 Guilford CONNECTICUT 06437
Attorney of Record	Mark Harrison
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICAN" APART FROM THE MARK AS SHOWN
Description of	

Mark Color is not claimed as a feature of the mark.
Type of Mark SERVICE MARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20140109.
Renewal 1ST RENEWAL 20140109
Live/Dead Indicator LIVE

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AMERICAN SPIRIT

Word Mark	AMERICAN SPIRIT
Goods and Services	IC 039. US 100 105. G & S: CRUISE SHIP SERVICES; TRANSPORTATION OF PASSENGERS BY SHIP. FIRST USE: 20050528. FIRST USE IN COMMERCE: 20050528
Mark Drawing Code	(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
Serial Number	76565019
Filing Date	December 12, 2003
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	September 14, 2004
Registration Number	2987886
Registration Date	August 23, 2005
Owner	(REGISTRANT) AMERICAN CRUISE LINES, INC CORPORATION DELAWARE 741 Boston Post Road, Suite 200 Guilford CONNECTICUT 06437
Attorney of Record	Mark Harrison
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICAN" APART FROM THE MARK AS SHOWN
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	LIVE

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AMERICAN STAR

Word Mark	AMERICAN STAR
Goods and Services	IC 039. US 100 105. G & S: CRUISE SHIP SERVICES; TRANSPORTATION OF PASSENGERS BY SHIP. FIRST USE: 20070600. FIRST USE IN COMMERCE: 20070600
Mark Drawing Code	(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
Serial Number	76565020
Filing Date	December 12, 2003
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	September 14, 2004
Registration Number	3409555
Registration Date	April 8, 2008
Owner	(REGISTRANT) AMERICAN CRUISE LINES, INC CORPORATION DELAWARE 741 Boston Post Road, Suite 200 Guilford CONNECTICUT 06437
Attorney of Record	Mark Harrison
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICAN" APART FROM THE MARK AS SHOWN
Description of	

Mark Color is not claimed as a feature of the mark.
Type of Mark SERVICE MARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR).
Live/Dead Indicator LIVE

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